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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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12/12/2006

Horst Keller

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6999

22442 7590 02/23/2010  
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EXAMINER

KHATRI, PRASHANT J

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### ATTACHMENT TO ADVISORY ACTION

In response to After-Final filed 2/3/2010. Claims 1-2, 4-13, and 15-21 are pending.

Claim 1 was amended. Claims 3 and 14 were cancelled.

This amendment will be entered.

Applicant's arguments filed 6/8/2009 regarding the 35 USC 103(a) rejections have been fully considered but they are not persuasive. Applicant asserts that there is no motivation provided by Erskine to include a binder into the resultant mineral wool of Battigelli, Bernard, and Trabbold. The Courts have made clear that the teaching, suggestion, or motivation test is flexible and an explicit suggestion to combine the prior art is not necessary. Given that binder as disclosed by Erskine is an organic binder that is found in the present range and provides for better handling and strength, it is clear that the motivation is present for one of ordinary skill in the art to apply a binder material (**col. 3, lines 39+**). Further, it is noted that Applicant has not provided any materials regarding the binder and since Erskine discloses an organic binder present in a mineral wool in the amount presently claimed, it is clear that Erskine meets the present limitations. Applicant further asserts that no motivation is provided Bernard and Trabbold regarding why the material should have particular diameters. However, it is noted that the reduction of gram weight while maintaining the desired insulating characteristics provides cost savings (**Trabbold; p. 19, lines 6+**). Concerning the Bihy

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reference, Applicant asserts that the prior art provides a binding that is above the presently claimed range. Examiner notes that Bihiy was not used to teach the amount of binding but the present limitations of the cutting marks and use of such an insulation for roofing of claims 9, 15, and 21.

Applicant further asserts that the combination does not fairly teach the present claims. In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PRASHANT J. KHATRI whose telephone number is (571)270-3470. The examiner can normally be reached on M-F 8:00 A.M.-5:00 P.M. (First Friday Off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Patricia L. Nordmeyer/  
Primary Examiner, Art Unit 1794

PRASHANT J KHATRI  
Examiner  
Art Unit 1794